

Regarding the Information Disclosure Statement filed Oct. 23, 2000 (Paper No. 7), Applicants herewith submit a revised listing of the same "Other Documents" numbered D1-D14, with more complete identification information as requested. Applicants respectfully request entry of this revised listing shown on the enclosed PTO/SB/08B, pp. 1 and 2.

Regarding Claims 1-11 and 12-16, rejected under 35 U.S.C. Sec. 102(e) as being anticipated by U.S. Pat. No. 6,123,259, *Ogasawara*, this rejection is respectfully traversed as follows.

The last step of Applicants' claim 1 recites: "*in response to* the retail processing system receiving the encoded information from the MRC and the transferred unique identification information, *transferring ownership* of the article of commerce to the user." (Emphasis added.) First, this step is not disclosed in *Ogasawara*. Second, this step is *not* inherent because the reference discloses *other* actions or steps that *result* from the store's core server receiving the scanned items UPC information and the unique terminal ID (or, alternatively unique customer ID). These *other* actions or steps that occur in response to receiving the scanned UPC and terminal (or customer) ID include, for example: (a) providing the location of the item or of a destination location for the next item indicated on a replenishment list; (b) generating and updating a replenishment table or shopping history of the particular customer; or (c) updating a customer profile for various purposes, such as developing promotional items keyed to the customer interests or habits.

As described therein, the system of *Ogasawara* operates to perform the foregoing operations (a, b and c in the preceding paragraph) which thus must be construed to be the normal, and indicative of the, inherent operations thereof. Since other undisclosed operations, such as *fetching* the items or *transferring possession* of or delivering the items are *not* disclosed, which are clearly obvious operations in a retail system or environment, it cannot be assumed that it necessarily follows that these other undisclosed operations are normal or inherent. The same applies to *transferring ownership*, a step or operation also not disclosed and, since it is somewhat non-intuitive as compared with transferring possession, a step that is also non-obvious, i.e., *not* inherent.

Accordingly, since *Ogasawara* fails to disclose the last step of Applicant's Claim 1 and the last step has been shown to not be inherent, this reference fails to anticipate Claim 1, and the dependent Claims 2-11 which depend directly or ultimately from Claim 1 and contain all the limitations of base Claim 1. System Claims 12-16, which parallel method Claims 1-5 are also believed to be not anticipated for the same reasons as Claims 1-11. Applicants respectfully request the withdrawal of these rejections an the allowance of Claims 1-16.

Regarding Claims 1-5 and 12-16, alternatively rejected under 35 U.S.C. Sec. 102(e) as being anticipated by U.S. Pat. No. 6,343,276, *Barnett*, this rejection is respectfully traversed as follows.

Applicant's invention is directed to a method and system "for initiating and completing a commercial transaction to acquire an article of commerce." In contrast, the cited reference to *Barnett* is directed to a system and method for tracking and searching inventory data regarding a retail article of clothing such as shoes. See, e.g., Col. 1, line 5 to Col. 3, line 4. The *Barnett* reference is different because it does not require or disclose at least one step or operation of Applicant's method (Claim 1) or system (Claim 12).

Barnett does not perform the last step of Claim 1, or operation set forth in the last subparagraph of Claim 12, of Applicant's invention. It is this step, or operation, which clearly differentiates the present application from *Bartlett*. *Barnett* doe *not* disclose initiating and completing a transaction . . . to transfer ownership of an article of commerce to a user. Applicant therefore respectfully submits that *Barnett* does not anticipate either Claim 1 or Claim 12, nor the dependent claims thereof, and requests that this rejection accordingly be withdrawn.

Regarding Claims 1-22, alternatively rejected under 35 U.S.C. Sec. 102(f) as subject matter not invented by the Applicant, the Applicant (and sole inventor) acknowledges that election of Species A, represented by FIGURE 25 which appears for the first time in the present Continuation-In-Part application filed June 20, 2000, entitles the Applicant to the filing date of the present application. Applicant respectfully submits that inventorship is therefore moot and this rejection should be

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withdrawn.

Applicant acknowledges the comments of the Examiner regarding functional recitations (Item 15, page 7) and the presumptions available (item 16, pages 7-9) to give claim terms their “plain meaning” or their “ordinary and accustomed meaning.” Applicant respectfully points out, however, that all terms used in the claims are supported in the specification. Some, such as “machine resolvable code (MRC)” are expressly stated and defined; others, such as “transfer of ownership” are clear from the context of the supporting description, to wit: completion or confirmation of a purchase transaction, from which one readily infers the transfer of ownership. Further, unless the Examiner has an express issue with the meaning of any term in the claim, Applicant can not address the meaning. Applicant is not required to expressly address such issues without more input from the Examiner.

Regarding Claims 1-11, alternatively rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over *Ogasawara*, this rejection is respectfully traversed as follows.

It is asserted by the Examiner that even if Claims 1-11 are not anticipated by *Ogasawara* “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Ogasawara* to include the claimed method.” Applicant respectfully points out (a) *Ogasawara* does not anticipate the present invention as shown hereinabove; and (b) the last step of Applicant’s base Claim 1, shown by Applicant to be missing from *Ogasawara*, has not been shown by the Examiner to be taught or suggested by any other reference or rationale other than to say it is “obvious.”

Further, Applicant demonstrated hereinabove that the last step of Claim 1, missing from *Ogasawara*, is not taught by this reference because the reference teaches away from Applicant’s step of transferring ownership; i.e., *Ogasawara* teaches instead (a) providing the location of the item or of a destination location for the next item on a replenishment list; (b) generating and updating a replenishment table or shopping history; or (c) updating a customer profile for developing promotions keyed to the customer interests or habits. Moreover, this reference does not even suggest other operations such as (d) fetching a selected item or (e) transferring possession or delivering the item to the

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customer. For these reasons Applicant respectfully submits that it has not been shown that claims 1-11 are obvious over the *Ogasawara* reference and thus requests the withdrawal of this rejection of Claim 1 and of Claims 2-11 dependent therefrom.

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-25,357 of HOWISON, THOMA & ARNOTT, L.L.P.

Respectfully submitted,
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

3. (Amended) The method of Claim 1, wherein the step of extracting the encoded information from the MRC [is] comprises the step of scanning a bar code.

4. (Amended) The method of Claim 3, wherein the step of scanning a bar code comprises the step of scanning a universal product code (UPC).

7. (Amended) The method of Claim 6, wherein the personal scanner is a wireless scanner, and the step of transferring comprises the step of wirelessly transmitting to the retail processing system both the extracted encoded information from the MRC and the unique ID.

8. (Amended) The method of Claim 6, wherein the retail processing system is operable, upon receipt of the unique ID and the extracted information from the MRC, to [extract] perform the steps of:

5 extracting from a lookup table user information about the user that is associated with the unique user ID, which association is created prior to the step of providing the personal scanner to the user[, and then]; and

completing the commercial transaction by transferring ownership of the article of commerce to the user associated with the user information.

11. (Amended) The method of Claim 5, wherein the step of transferring occurs after multiple ones of the MRCs have been stored in association with multiple articles of commerce, and wherein the step of transferring ownership of the article of commerce to the user comprises the step of transferring ownership of all of the 5 articles of commerce to the user.

16. (Amended) The system of Claim 12, and further comprising a personal scanner having a memory associated therewith which is transferrable to a user [to

said user], wherein said MRC is scanned with said personal scanner and said encoded information from said scanned MRC is stored in said memory.

20. (Amended) The system of Claim 17, wherein [a record in a database is created at said retail processing system] said retail processing system further comprises a database having a record of said user of said personal scanner such that said user is associated with said unique scanner ID at said retail processing system
5 prior to providing said personal scanner to said user.

21. (Amended) The system of Claim 16, wherein said extracted encoded information from the MRC and said unique identification information [is] are transferred after said MRC is scanned.

22. (Amended) The system of Claim 16, wherein said extracted encoded information from said respective MRCs and said unique identification information [is] are transferred after multiple ones of said MRCs have been stored in association with multiple articles of commerce, and wherein when ownership in one article of
5 commerce is transferred to said user, ownership of all of the articles of commerce are transferred to said user.